

The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JIMMY F. HOLCOMB

Appeal No. 2003-1645
Application 09/803,720

ON BRIEF

Before GARRIS, WARREN and OWENS, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellant, in the brief, and reply brief and based on our review, find that we cannot sustain the rejection of appealed claims 1 through 3,¹ all of the claims in the application, under 35 U.S.C. § 103(a) as being unpatentable over Welch.²

We refer to the examiner's answer and to appellant's brief and reply brief for a complete exposition of the opposing positions advanced on appeal.

It is well settled that in order to establish a *prima facie* case of obviousness under § 103(a), the examiner must show that some objective teaching, suggestion or motivation in the

¹ See the appendix to the brief

² Answer, pages 3-4.

applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims arranged as required by the claims, without recourse to the teachings in appellant's disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988).

Even a cursory comparison of the elements of the claimed cable reel level winding device arranged as required in the appealed claim 1,³ as interpreted in light of the written description in the specification and the specification drawings, and the elements of the line-distributing device for reels disclosed by Welch (e.g., page 1 and **FIGs. 1-4**), supports appellant's contentions that the examiner has failed to read Welch on a number of claim elements arranged as required, including, *inter alia*, the cam and cable guide arm arrangement as specified in appealed claim 1 (brief, pages 4-6; reply brief, pages 1-3). The examiner advances three reasons in support of the position that the apparatus disclosed by Welch has "substantially all the claimed features" (answer, page 3).

We find it necessary to our decision to discuss only the third reason advanced by the examiner. The examiner contends that the line guide structure of Welch reads on the cable guide structure of appealed claim 1 (answer, page 4). To place the examiner's position in perspective, we find that in Welch **FIGs. 2-5**, line guide arm **20** contains head **24** that travels in cam groove **18**, is attached by pin **23** in slot **21** of pillar **22**, and has eye **26** for the line. The line guide arm **20** moves back and forth at a constant speed with the rotative force applied by crank **16**, pivoting at pin **23** (page 1, lines 44-90). The clauses of appealed claim 1 involved here read as follows:

a cam follower in said [cam] groove and driven thereby, an arm carrying said cam follower and oscillated back and forth thereby,

³ We decide this appeal on appealed claim 1 because appellant states in the brief (page 3) that the appealed claims "stand or fall together" and the examiner agrees (answer, page 2) 37 CFR § 1.192(c)(7) (2002).

a fourth shaft mounted for rotation in said housing and engaged with said cam follower so as said cam follower oscillates back and forth, said fourth shaft oscillates back and forth, and

a cable guide arm mounted on said fourth shaft and having a cable guide eye through which the cable passes so that when same cam is rotated in either direction, said cam causes said cam follower arm to oscillate back and forth causing said fourth shaft to oscillate back and forth thereby causing said cable guide to oscillate back and forth so that the cable passing through said eye is wound evenly on said cable reel.

According to the examiner, “[t]he ‘fourth shaft’ reads on the portion of shaft **20** below the pivot **23**,” “[t]he ‘cable guide arm,’ which carries guide eye **26**, reads on the portion of shaft **20** above pivot **23**”; and “[t]he ‘cable guide arm’ connects the guide eye to the ‘fourth shaft’ . . . [which] is centrally mounted as shown in fig. **2**” (answer, page 4). Appellant submits that “[a]s shown in Figures **2** and **4** . . . the cam follower **39** is mounted on a shaft **50** which oscillates or rotates back and forth and rotates shaft **57** (the fourth shaft recited in claim 1) which in turn, has the arm **60** mounted thereon so that arm **60** oscillates back and forth with oscillation of shaft **57** – quite a different structure than the second-class lever of . . . Welch” (brief, page 6).

We find that the limitations in appealed claim 1 read on the structure that appellant identifies in specification **FIGs. 2** and **4** and not the structure of Welch as alleged by the examiner. A comparison of these two structures in light of the limitations set forth in appealed claim 1 establish that there indeed several differences. The examiner does not identify the structure and function in Welch for certain claim limitations, such as the “arm carrying said cam follower and oscillates back and forth thereby,” which “cam follower arm” engages the “cam follower” with “a fourth shaft mounted for rotation in said housing” such that the “cam causes said cam follower arm to oscillate back and forth causing said fourth shaft to oscillate back and forth thereby causing said cable guide to oscillate back and forth.” The examiner has not advanced a position that one of ordinary skill in this art would have found it obvious to modify the apparatus of Welch in these respects.

Accordingly, because it is apparent that the line-distributing device for reels disclosed by Welch does not read on the elements of the claimed cable reel level winding device arranged as required in the appealed claim 1, we reverse the rejection of appealed claims 1 through 3 under 35 U.S.C. § 103(a).

The examiner's decision is reversed.

Reversed

BRADLEY R. GARRIS
Administrative Patent Judge

CHARLES F. WARREN
Administrative Patent Judge

TERRY J. OWENS
Administrative Patent Judge

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